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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/12/2003

James McLennan

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EXAMINER

BAROT, BHARAT

ART UNIT

PAPER NUMBER

2155

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DELIVERY MODE

05/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/706,867	MCLENNAN ET AL.	
	Examiner	Art Unit	
	Bharat N. Barot	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/21/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Claims 1-28 and 33; and new claims 34-35 remain for further examination.

The old rejection maintained

2. Applicant's arguments with respect to claims 1-28 and 33 filed on February 11, 2008 have been fully considered but they are not deemed to be persuasive for the claims 1-28 and 33. The rejection is respectfully maintained as set forth in the last Office Action mailed on September 11, 2007.

Claim Objections

3. Claim 5 is objected to because of the following informality:
Claim 5 line 1 "claim 5" should be --**claim 4**--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-28 and 33-35 are rejected under 35 U.S.C.103 (a) as being unpatentable over Pollack (U.S. Patent No. 6,505,236) in view of Powers (U.S. Patent No. 6,438,584).
6. As to claim 1, Pollack teaches a method for directing an automatic communication to a recipient (see abstract; and figures 1-2), including the steps of: providing a data store; storing data relating to the recipient in the data store; examining

the data stored and determining that a communication is to be provided to the recipient; extracting data relating to the recipient from the data store in response to a determination that a communication is to be provided to the recipient; modifying an initial communication to become a final communication selectable in response to the extracted stored data; and sending the final communication to the recipient (figures 1-2; column 4 line 4 to column 7 line 17).

However, Pollack does not teach the steps of: automatically composing an initial communication in response to the data stored in the data store; and passing the initial communication to be modified to become a final communication, which is optional.

Powers teaches the steps of: automatically composing an initial communication in response to the data stored in the data store; passing the initial communication to be modified to become a final communication; modifying the initial communication in response to a determination that the initial communication is to be modified to become a final communication is optional; and sending the final communication to the recipient (see abstract; figure 1; column 3 line 39 to column 4 line 39; and column 14 lines 10-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Powers stated above in the method of Pollack for directing an automatic communication to a recipient because it would have promoted efficient planning and work flow in the network and maximized the utilization of the network by limiting the sizes of the messages.

7. As to claim 2, Pollack teaches that the step of: modifying the initial communication comprises modifying the initial communication in a manner selected in response to the data extracted from the data store (figures 1-2; column 4 lines 3-39; and column 7 lines 1-6).

8. As to claim 3, Pollack teaches that the step of: modifying the initial communication comprises at least one of: deleting material from the initial communication; adding new material to the initial communication; providing material of predetermined fixed content and adding the material of predetermined fixed content to the initial communication; providing material of predetermined alterable content and adding the material of predetermined alterable content to the initial communication; and altering material already provided in the initial communication (figures 1-2; column 5 lines 17-67; and column 7 lines 6-10).

9. As to claims 4-5, Powers teaches that the steps of: providing access to a plurality of selectable media for providing the final communication to the individual; selecting, in response to the data extracted from the data store, at least one medium of the plurality of selectable media for providing the final communication to the individual; and employing said at least one medium to send the final communication, wherein the plurality of selectable media comprises facsimile transmission; telephonic text messaging; data transmission; Internet Communication; and mailing of printed letters (figure 1; and column 14 line 61 to column 15 line 11).

10. As to claims 6-7, Powers teaches that the steps of: providing access to a plurality of selectable media for providing the final communication to the individual; selecting, in response to the data stored, at least one medium of the plurality of selectable media for providing the final communication to the individual; and employing said at least one medium to send the final communication, wherein the plurality of selectable media comprises facsimile transmission; telephonic text messaging; data transmission; Internet Communication; and mailing of printed letters (figure 1; and column 14 line 61 to column 15 line 11).

11. As to claim 8, Pollack teaches that the step of: storing data relating to the recipient in a data store comprises the step of providing access to and accepting data relating to the recipient from at least one of: the Internet; a digital data transmission medium; telephonic text messages; telephonic voice messages; printed matter; data files; and record data files (figure 1; and column 5 lines 17-36).

12. As to claims 9-10, Powers teaches that the steps of: automatically composing an initial communication in response to the data stored in the data store comprises the step of providing composition text in a plurality of languages, selecting one of the languages in response to the data stored relating to the recipient and composing the initial communication in the language selected, wherein the step of modifying the initial communication comprises modifying the initial communication in a same language as a language selected for the initial communication (figure 1; and column 15 lines 3-60).

13. As to claims 11-12, Pollack teaches that the step of: automatically composing an initial communication in response to the data stored in the data store includes the step of providing a plurality of idioms for the initial communication and selecting one of the plurality of idioms for the initial communication in response to data relating to the recipient extracted from the store, wherein the step of modifying the initial communication comprises modifying the initial communication in a same idiom as an idiom selected for the initial communication (figure 1; and columns 4-5).

14. As to claims 13-14, Powers teaches that the steps of: automatically composing an initial communication in response to the data stored in the data store includes the step of providing a plurality of forms of composition suitable for use in respective individual jurisdictions; and selecting a particular jurisdiction with the respective form of composition in response to the data relating to the recipient extracted from the store; and, composing the communication in the respective form of composition, wherein the step of modifying the initial communication comprises modifying the initial communication with material suitable for use in a same jurisdiction as the initial communication (figures 1 and 4-8; columns 14-15; and column 16 lines 6-67).

15. As to claims 15-28, they are also rejected for the same reasons set forth to rejecting claims 1-14 above, since claims 15-28 are merely an apparatus for the method of operation defined in the claims 1-14.

16. As to claims 33-35, claims 29-33 do not teach or define any new limitations than above claims 1-14; therefore, they are rejected for the similar reasons.

Response to Arguments

17. Applicant's arguments with respect to claims 1-28 and 33 filed on February 11, 2008 have been fully considered but they are not deemed to be persuasive for the claims 1-28 and 33. In the remarks, the applicant argues that:

(A) Argument: Pollack does not teach the provision of a template along the lines of the present invention - a template which includes embedded logic which determines whether or not selected portions of data or text are to be enclosed in an automatic communication. Moreover, Pollack does not suggest or disclose a step for determining whether an initial communication is required to be modified before becoming a final communication.

Response: Pollack explicitly teaches a method including: determining whether or not selected portions of data or text are to be enclosed in a final communication (figure 1; and column 5 lines 17-50); and determining whether an initial communication is required to be modified before becoming a final communication (figures 1-2; column 5 lines 17-50; and column 6 line 66 to column 7 line 17).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a template which includes embedded logic which determines whether or not

selected portions of data or text are to be enclosed in an automatic communication) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed.Cir.1993).

(B) Argument: Examiner has failed to establish a prima facie case of obviousness and not shown that there is some suggestion or motivation to modify references.

Response: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir.1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.Cir.1992).

In this case, Pollack does not teach the steps of: automatically composing an initial communication in response to the data stored in the data store; and passing the initial communication to be modified to become a final communication, which is optional.

Powers teaches the steps of: automatically composing an initial communication in response to the data stored in the data store; passing the initial communication to be modified to become a final communication; modifying the initial communication in response to a determination that the initial communication is to be modified to become a final communication is optional; and sending the final communication to the recipient

(see abstract; figure 1; column 3 line 39 to column 4 line 39; and column 14 lines 10-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Powers stated above in the method of Pollack for directing an automatic communication to a recipient because it would have promoted efficient planning and work flow in the network and maximized the utilization of the network by limiting the sizes of the messages.

(C) Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2155

Contact Information

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose Telephone Number is **(571) 272-3979**. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Saleh Najjar**, can be reached at **(571) 272-4006**.

/Bharat N Barot/

Primary Examiner, Art Unit 2155

May 05, 2008